SN

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,570	12/28/2001	James P. Campbell	2001-120-TAP	1548

7590 11/10/2003

STORAGE TECHNOLOGY CORPORATION
One StorageTek Drive
Louisville, CO 80028-4309

EXAMINER	
TRAN, KHOI H	

ART UNIT	PAPER NUMBER
3651	

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Interview Summary	Application No.	Applicant(s)	
	10/034,570	CAMPBELL ET AL.	
	Examiner	Art Unit	
	Khoi H Tran	3651	

All participants (applicant, applicant's representative, PTO personnel):

(1) *Khoi H Tran*. (3)_____.

(2) *Mr. Stephens R. Tkacs*. (4)_____.

Date of Interview: *04 November 2003*.

Type: a)☒ Telephonic b)☐ Video Conference
c)☐ Personal [copy given to: 1)☐ applicant 2)☐ applicant's representative]

Exhibit shown or demonstration conducted: d)☐ Yes e)☒ No.
If Yes, brief description: _____.

Claim(s) discussed: *1-15*.

Identification of prior art discussed: *none*.

Agreement with respect to the claims f)☐ was reached. g)☒ was not reached. h)☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: *Discussion on whether the Notice Non-responsive Amendmend 10/27/2003 is proper. see attached page*.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record
A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews
Paragraph (b)
In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.
All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:
- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:
1) A brief description of the nature of any exhibit shown or any demonstration conducted,
2) an identification of the claims discussed,
3) an identification of the specific prior art discussed,
4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
5) a brief identification of the general thrust of the principal arguments presented to the examiner,
   (The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
6) a general indication of any other pertinent matters discussed, and
7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

INTERVIEW SUMMARY

1. As indicated in the Notice of Non-responsive Amendment filed on 10/27/2003, the newly submitted and amended claims 1-15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The original claims are directed to a method for scaling a storage library having the steps of increasing the horizontal width and horizontal length of the storage library. The newly amended and added claims are not directed to the original invention. Instead, they are directed to a scalable storage library with the particulars of the cell arrays, robot mechanism, and cartridge player. These new claims are independent and distinct from the original non-amended claims.

Applicant has received an action on the merits for the originally presented invention. Thus, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, none of the new claims are directed to the original invention. See 37 CFR 1.142(b) and MPEP § 821.03. Therefore, the mailing of the Notice of Non-Responsive Amendment is considered to be proper.

Since none of the original claimed invention is presented in the instant case, an actual restriction requirement was not possible. However, for Applicant better understandings, a hypothetical situation in support of the Office position is followed.

If the instant newly amended and added claims were presented with the original non-amended claims, the following restriction would apply.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-7 (original non-amended claims), drawn to a method of scaling a storage library, classified in class 700, subclass 214.

II. Claims 1-15 (newly added and amended claims), drawn to a scalable storage library with the particulars of the cell arrays, robot mechanism, and cartridge player, classified at least in class 369, subclass 30.39 or 75.1.

The inventions would be distinct, each from the other because inventions II and I are related as combination and subcombination. Inventions in this relationship would be distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In this hypothetical case, the combination of invention II as claimed would not required the particulars of the subcombination as claimed because the combination would not required the particulars of increasing the horizontal width and length of the storage library for patentability. The subcombination would have separate utility such as for increasing the size of a storage library without a cartridge player, or without a robot mechanism. The subcombination would have separate utility such as for increasing the size of a book storage library.

3. Because inventions I and II would be distinct for the reasons given above and would have acquired a separate status in the art as shown by their different classification, the restriction as indicated would be proper.

4. Applicant has received an action on the merits for the originally presented invention (Invention I). This invention has been constructively elected by original presentation for prosecution on the merits. Since none of the newly amended and added claims are directed to the originally presented invention, the mailing of the Notice of Non-responsive Amendment is considered proper.

5. Applicant attention is also directed to MPEP 821.03 and chapter 800 for a better understanding of USPTO Restriction Practice.

6. Please note that the one month or 30 days statutory period of response is still running as of the mailing date of the Notice of Non-Responsive Amendment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H. Tran whose telephone number is (703) 308-1113. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Ellis can be reached on (703) 308-1113. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Khoi H Tran
Primary Examiner
Art Unit 3651

KHT
11/06/2003